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EXAMINER

LE, HIEU C

ART UNIT PAPER NUMBER

2142

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,216

Applicant(s)

KITAMURA, YOSHIMASA

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-21-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) **AC**
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The amendment filed 12/21/04 have been entered and made of record.
2. The Applicant 's argument filed 12/21/04 have been fully considered but they are moot in view of new ground.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "using the selected data which is not downloaded thereto" lines 10-11. There is no recitation of not down loading the transmitted selected data, anywhere in the specification as originally filed. In fact on page 3, lines 15-27. The specification recites "partial data or partial images for authoring a sending data or a sending image are stored and that the sending data or the sending images is transmitted via the server to a receive side, so that authoring and transmission of data or images become possible without increasing the storage capacity of memory of a mobile tool". It is not clearly that all images are stored on a server and selected portions for authoring are transmitted from the server to the mobile receiver to accommodate the small capacity of the storage of the mobile tool and if the storage capacity is of the level

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to be able to display the images on a display, thereby eliminating the need for large sized storage i.e, the selected portion is transmitted and stored in the small storage capacity of the mobile receiver (downloaded). The invention as originally filed is stored plurality of images on server with big storage capacity and then transmit only selected portions of the images that accommodates the small capacity storage of the mobile receiver are downloaded by the receiver, and the storage capacity of the mobile tool able to display it.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specifications are not clear on how "using the selected data which is not downloaded thereto".

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2,5,7-9, 12,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, David et al [W0 9937105].

As to claim 1, Walker discloses a method transmitting information between transmitting terminal and receiving terminal via the internet wherein at least one of the transmitting terminal and other receiving terminal is a mobile tool, comprising the steps of:

storing in a server on data constituting parts of a sending data be transmitted from said transmitting terminal to said receiving terminal [Fig. 1 shows a server accessed by clients to compose a graphic message (sending data) from image component objects (data constituting parts of a sending data) that is stored in a server database, the graphic message is sent from a sending portable phone to a receiving portable phone (p. 3, lines 1-7, p. 5, lines 20-24)

selecting one or more from said stored data by means of operating the transmitting terminal (p3, lines 3-9).

authoring said sending data display unit the transmitting terminal by using the data stored by using the selected data which is not downloaded thereto [the sender device under the direction of the user selects and downloading one or more image component objects while the image component object stored on the server (p. 3, lines 1-9). The selected image component objects are rendered on the sender's screen by editing and drawing the component objects by the user to generate a graphic objects by the user to generate a graphic message (sending data(p. 4, lines 2-13, p. 5, lines 12-15, lines 20-28)];

storing said sending data in said server [the message (sending data) is stored at the server (p. 5 lines 5-7)];

distributing said sending data stored in said server to said receiving terminal [messages are transmitted via server to the message receiving apparatus (i.e., distributed) (p. 2, lines 20-21)] and

displaying the sending data distributed on a display unit of the receiving terminal

(p. 2, lines 20-21).

Walker discloses that the server and the mobile apparatus are connected via a communication link (p. 3, lines 5-6).

Walker does not disclose that the communication link is the Internet.

However, the use of the Internet is obvious in view of a communication link and one of ordinary skill in the art at the time the invention was disclosed would be motivated to use the Internet which is a popular and numerous cluster of different networks connecting different and diverse users and devices across the world.

As to claim 2, Walker further discloses wherein the data stored in the Internet server is character data or images data (p. 4, lines 2-10, p. 5, lines 12-28, p. 6, lines 13-27).

As to claim 5, Walker further discloses wherein the transmission of the information is conducted using a mobile tool as said transmitting terminal and said receiving terminal (p. 4, lines 13-15).

As to claim 7, Walker further discloses wherein the step of displaying said sending image on said display unit of said receiving terminal includes a step draw a replying image by calling said images from said Internet server and modifying a part of said sending image (p. 4, lines 2-10, p. 5, lines 20-28).

As to claim 8, refer to claim 1 rejection.

As to claim 9, refer to claim 2 rejection.

As to claim 12, refer to claim 5 rejection.

As to claim 14, Walker further disclose wherein the selected portion of the stored data is a first selected portion, and further comprising:

selecting a second portion of the stored data using the receiving terminal, and modifying the displayed sending data on the display unit of the receiving terminal with the selected second portion of the stored data to form reply data (col. 3, lines 24-31, p.5, line 29-p. 6, line 23).

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4, 10-11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, David et al [W0 9937105] as applied to claims 1 & 8 and further in view of Deluca, Joan WO 97/19429.

As to claim 3, Walker discloses graphics image data. However, Walker does not disclose explicitly wherein the image data is data of each part of a face.

Deluca discloses a data communication system where graphic image messages are received by a mobile receiver, the graphic data conveys in pictures a universally understood meaning to the user of the receiver (p. 4, line 31-p. 5, line 2, figs. 3 & 8). As shown by figs. 3-8 the graphic image data represent different objects, such as a person, a house, etc. Face as an object and image data represent parts of a face is obvious in view of image data represent other similar objects disclosed by Deluca.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Deluca's teachings to modify the method of Walker by using image data of each part of a face in order to graphic messages to the user of the receivers to convey an easily understood universal message which add to the appeal and understandability of the message.

As to claim 4, Walker does not disclose the step distributing the sending data stored in the Internet server to the receiving terminal is conducted by distributing an Address having access to the sending data stored in the Internet server, and the step of display the sending data distributed on a display unit of the receiving terminal is conducted by accessing the address.

Deluca discloses a data communication system where a terminal 105 (server) transmitting information to the data receiver 100, the server includes a memory 315 for storing addresses associated with receivers and an encoder to encoded messages and addressed using a communication protocol to transmit the information as a radio signal to the receiver (p. 9, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Deluca's teachings to modify the method of Walker by distributing an address having access to the sending data stored in the Internet server and displaying the sending data on a display unit of a receiving terminal by accessing the address in order to display graphic messages to the user of the receivers to convey an easily understood universal message which add to the appeal and understandability of the message.

As to claim 10, refer to claim 3 rejection.

As to claim 11, refer to claim 4 rejection.

As to claim 13, Walker does disclose transmitting a telephone message to urge displaying of the sending data on the display unit of the receiving terminal.

Deluca discloses a data communication system where messages are sent to mobile receiver as radio signals (Fig. 1, p. 7, line 33- p. 8, line 2). The message includes a command to display the received message (p. 4, line 34-p. 5, line 2, p. 11, lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Deluca's teachings to modify the method of Walker by transmitting a telephone message to urge displaying of the sending data on the display in order to display graphic messages to the user of the receivers to convey an easily understood universal message which add to the appeal and understandability of the message.

Claim 6 would be allowable if overcome the 112, first paragraph rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (571) 272-3897.

The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Caldwell Andrew, can be reached on (571) 272-3868. The fax phone number for this Group is (571)-273-3897.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 273-8300.

Hieu Le

A handwritten signature in black ink that reads "Andrew Caldwell". The signature is written in a cursive, flowing style.

**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**